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JAN 25 2002

In re Application of
Raphael Mestanza
Application No. 09/313,063
Filed: May 17, 1999
Attorney Docket No. 8CL-7194

OFFICE OF PETITIONS

In re Application of
Raphael Mestanza
Application No. 09/887,698
Filed: September 22, 2000
Attorney Docket No. 8CL-7194(GP1-0075)

DECISION GRANTING PETITION

This is a decision on the petition filed January 9, 2002, requesting that a Continued Prosecution Application (CPA) filed September 22, 2000, based on prior application No. 09/313,063 be treated as an application under 37 CFR 1.53(b) and accorded a filing date of September 22, 2000.

The request for a CPA based on prior application No. 09/313,063 was deposited on September 22, 2000¹. Since the issue fee was paid in the prior application on July 19, 2000, a petition to withdraw the application from issue was also filed on September 22, 2000. However, the petition and the file of the prior application were not received by the appropriate official within sufficient time to avert issuance of the prior application as U.S. Patent No. 6,136,945 on October 24, 2000. Accordingly, the CPA request cannot be processed as a proper CPA.

The present petition is filed in response to the decision mailed October 22, 2001, in the prior application. Petitioner requests that the request for a CPA be treated as a continuation application filed under 37 CFR 1.53(b). The petition is accompanied by, *inter alia*, a specification, drawings and a copy of a signed declaration from the prior application.

The petition is granted. Under the circumstances of this case, no petition fee has been charged to counsel's deposit account, nor is one due.

¹A copy of the papers filed on September 22, 2000 were provided on October 16, 2001. While the original papers cannot be located, the evidence is convincing that the papers were filed on September 22, 2000, and subsequently misplaced in the PTO.

The continuation application under 37 CFR 1.53(b) has been assigned application No. 09/887,698. All further correspondence concerning the continuation application filed on February 20, 2001, should be directed to application No. 09/887,698.

In view of this decision, a copy of the CPA request and post card receipt dated September 22, 2000 provided on October 16, 2001, and the petition filed on January 9, 2002, have been removed from the file of Application No. 09/313,063 and placed in the file of application No. 09/887,698. The CPA filing fee paid in Application No. 09/313,063 on September 22, 2000 will be applied to Application No. 09/887,698.

Since the petition under 37 CFR 1.313(c) was timely filed but a decision thereon was not rendered prior to the parent application issuing as a patent, the procedures set forth below should be followed.

If the information disclosure statement (IDS) filed along with or referred to in the petition under 37 CFR 1.313(c) complies with the requirements of 37 CFR 1.97 and 1.98, it will be considered by the examiner in the continuing application filed under 37 CFR 1.53(b).

The examiner should make all applicable prior art rejections in the 37 CFR 1.53(b) application (not just include a statutory double patenting rejection under 35 U.S.C. 101) based on the information cited in the IDS, alone or with other information, including any new art found in updating an old search or performing a new search.

If the examiner determines that the information cited in the IDS, alone or in combination with other information does not raise a question of unpatentability with respect to the claims in the continuing application (which are identical to the claims in the parent patent), then the examiner should make a statutory double patenting rejection under 35 U.S.C. 101. Applicant may then abandon the continuing application.

If the examiner determines that the information cited in the IDS, alone or in combination with other information raises a prima facie case of unpatentability with respect to the claims in the continuing application (which are identical to the claims in the parent patent), then the examiner should make the appropriate prior art rejection along with the statutory double patenting rejection under 35 U.S.C. 101. If prosecution of the continuing application results in an amendment of the claims due to unpatentability, a statutory disclaimer of the unpatentable claims must be filed in the parent patent, and a terminal disclaimer can be filed in the continuing application if the amended claims would have been obvious over any claim of the parent patent so as to permit the continuing application to issue with the amended claims.

Prior Application No. 09/313,063 is being returned to the files repository.

Application No. 09/887,698 is being forwarded to Initial Patent Examination Division for processing as a continuation application under 37 CFR 1.53(b), not as a CPA under 37 CFR 1.53(d), with a filing date of September 22, 2000, using the copy of the specification, drawings and declaration supplied on January 9, 2002.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-9220. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.

Sherry D. Brinkley

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